(25)

IN THE

Supreme Court of the United States

OCTOBER TERM, 1942

No. 530

THE SWAN CARBURETOR COMPANY,
Petitioner,

vs.

CHRYSLER CORPORATION,
Respondent.

RESPONDENT'S BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

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INDEX

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This is a suit, in the usual form, for the alleged infringement of two patents relating to intake manifolds for internal combustion engines.

Petitioner's complaint was dismissed by the District Court on the ground of non-infringement. 34 F. Supp. 766; V, 1822-1832. The Circuit Court of Appeals for the Sixth Circuit affirmed, holding all of the claims in suit either invalid or not infringed. 130 F. (2d) 391; V, 1851-1859.

The decision sought to be reviewed is manifestly right, and is not in conflict with any decision on the patents in any other Circuit. It involves nothing more than the reversal, by the Circuit Court of Appeals of the Sixth Circuit, on a more complete record, of part of an earlier decision of a District Court in the same Circuit. The controlling principles of law are all well settled. The single patent to which the petition is directed is no longer in force, having expired in April, 1942.

There is no reason for the granting of a writ of certiorari to review this ordinary patent infringement suit, in which no question of general or public interest or importance is involved.

The Nature of Swan's Alleged Invention.

There were two patents in suit, Swan patents 1,636,721, application filed in 1921, and 1,536,044, application filed in 1924 as an alleged division of the original application. Although the decision below was against petitioner on both patents, the petition is confined to the "divisional" patent '044.

The intake manifold of an internal combustion engine, to which the patents in suit relate, is the passageway or piping through which the combustible mixture of gasoline and air passes on its way from the carburetor (where the mixture is formed) to the cylinders (where it is exploded to furnish the driving force). All of the manifolds involved in this case are of the simple and conventional "T" type, in which the mixture is led from the carburetor through a vertical riser to a longitudinal header, from which three transverse branches (one from each end of the header and one from its middle) lead to the engine cylinders. In six-cylinder engines, such as are involved in this case, each branch of the manifold serves two cylinders. A manifold has no moving parts, but serves simply as a passageway or conduit through which the mixture is drawn from the carburetor to the cylinders by the suction of the pistons. The manifold influences the distribution of the mixture among the several cylinders solely by reason of its shape or configuration.

The earliest examples of these conventional T type manifolds disclosed in the present record are manifolds used on the Fiat automobile in 1907 and on the Matheson "Silent Six" automobile, 1910-1913. In both of these prior art T type manifolds the passageways were of round

cross-section, and at least some of the turns within the manifolds were rounded bends.

In the early days of motoring, in which these T type Matheson and Fiat manifolds were used, the gasoline sold for automobile use was highly volatile, and at normal temperatures of operation much of the gasoline in the mixture passing through the manifold was in vapor, rather than in liquid, form. These early manifolds functioned very well to distribute such dry, or relatively dry, mixtures evenly among the several cylinders.

Later on, at the time of the first world war, the heavy demands for gasoline necessitated the inclusion in commercial gasoline of some of the less volatile constituents of petroleum, so that at the same normal temperatures of operation, much of the gasoline in the mixture would be in liquid form instead of vapor as before.

Two solutions were proposed for the resulting "wet mixture problem", as it is called by the petitioner. The first of these (the solution which was generally adopted and was adopted by respondent) was to apply heat, from the exhaust or elsewhere, to vaporize the gasoline to a degree comparable to that occurring without heat with the earlier more volatile gasoline. The resulting dry, or relatively dry, mixture could naturally be distributed by the old forms of manifold in exactly the same way as the earlier mixtures having a corresponding degree of vaporization.

The other proposed solution of the "wet mixture problem", the one proposed by Swan, (which respondent did not adopt) was not to rely on heat, but to make changes in the shape of the manifold to enable it to distribute better the unvaporized portion of the fuel.

The manifold proposed by Swan to distribute "wet mixtures", without reliance on heat for vaporization of the liquid portion of the fuel, had a riser, header and branches arranged in exactly the same way as in the earlier Matheson and Fiat manifolds. The only differences were that in Swan's manifold the passageways were square, instead of

round, and that at all points within the manifold where the mixture was required to change direction, Swan provided sharp, square corners instead of round ones. A plan view of the Swan manifold is shown at the top of the chart facing page 8, *infra*.

Swan filed a patent application disclosing this unconventially shaped square manifold in 1921. In this patent application it was asserted that great benefits were derived from the use of the flat floor and the flat roof (which resulted from the use of passageways of square cross-section) and from the use of sharp, square corners at the turns. The flat floor was supposed to permit the liquid fuel to spread out and be more readily entrained by the rush of air through the manifold than would the narrow stream of liquid lying in the bottom of a passageway of conventional round cross-section. And in passing around the square corners of the Swan manifold the liquid portions of the mixture were supposed to splatter and rebound, thus remixing with the air.[1]

Petitioner demonstrated this new square manifold to the head of the Buick Division of General Motors and the manifold was adopted and used on the Buick cars of 1924, under license from petitioner. After a short period of use, however, General Motors found that the Swan manifold was no more effective than a manifold of the conventional round cross-section, when used with a heater to vaporize a sufficient portion of the liquid fuel. General Motors therefore substituted a conventional round cross-section manifold for the Swan square manifold, and declined to pay any royalties thereon. These round General Motors manifolds were put on the market about the middle of 1924, and at about the same time a similar manifold was adopted by the Nash Company, whose engine was similar to that of Buick.

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[1] File Wrapper, Defendant's Exhibit 140, *Reeke-Nash* record, Vol. IV, pp. 2090-2097.

Up to the time of the adoption of these manifolds of conventional round cross-section by Buick and by Nash, no claim had been made by Swan that he was the inventor of such manifolds. On the contrary, such round cross-section manifolds represented Swan's point of departure from the prior art and were contrasted with Swan's manifold, both in Swan's arguments to the Patent Office and in a technical paper which he wrote, in conjunction with two of petitioner's other engineers, for publication in the Journal of the Society of Automotive Engineers in 1923.[1] Up to this time Swan's alleged invention consisted only in making square a manifold which before had been made round, and in the use of sharp square corners at the turns.

To obtain a basis for claiming tribute on such round manifolds as those adopted by Nash and General Motors, petitioner, in November, 1924, several months after the Nash and General Motors manifolds had been placed upon the market, filed a second patent application as an alleged "division" of the original application of 1921. In this 1924 "divisional" application Swan first advanced claims to the invention of a "method of distribution" of a mixture by a manifold, describing the "method" in terms so broad and ambiguous as to be capable of being construed in such a way as to cover the normal operation of any satisfactory T type manifold, including the conventional T type manifolds used by Matheson and Fiat, ten years or more before Swan.

Swan also asserted claims to fragmentary portions of the manifold structure, describing them functionally, in terms of the desired result, so as to cover, if possible, any structure producing results which were commercially acceptable.

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[1] *Ibid.*, pp. 2109-2112, 2116, 2119-2124; *Chrysler* record, Vol. V, pp. 1665, 1668-1670, 1674, 1678. See also the succinct statement by Swan himself, in the discussion following the presentation of this paper, reproduced as an Appendix to this brief, *infra*, p. 19.

The reasons of the Patent Office for granting these ambiguous and functional claims do not appear, for the prosecution of the divisional application was conducted mainly by *ex parte* conferences with the examiner and the claims were allowed after a number of amendments without a single intervening action by the examiner (*infra*, p. 16).

In any event, patent 1,536,044 was granted in 1925, upon this "divisional" application, containing a number of ambiguous and indefinite "method" claims, and some apparatus claims, some of which were objectionably functional in character.

Later on, in 1927, patent 1,636,721 was granted upon Swan's original application, containing claims defining the shape of the Swan manifold as originally presented. Two claims of this original Swan patent, '721, were in suit in the present case and were properly held by both the District Court and by the Circuit Court of Appeals to be not infringed by any of respondent's manifolds, all of which, like the prior art Matheson and Fiat manifolds, have passageways of round cross-section, and have rounded bends instead of square ones. Although this patent, '721, which was granted on the original application, is still in force, and will remain in force until 1944, the petition for certiorari is limited to the later applied for "divisional" patent, '044, which expired some months ago.

The Decision in the Case at Bar Is Manifestly Right.

Three types of manifold used by respondent are involved in the present case (designated in the case as the Dodge, Dodge-Plymouth and DeSoto manifolds). Each of these manifolds is of round cross-section, like the prior art, instead of square like Swan. Also, each of respondent's manifolds has rounded bends instead of square corners at the turns from the header to the branches. These bends are even more rounded (i. e., further removed from square)

than the rounded bends of the prior art manifolds, with which Swan contrasted his square corners.

In addition, the passageways in respondent's Dodge-Plymouth and DeSoto manifolds (the most important ones in point of numbers produced and the only ones that were tested in this case) run uphill and down again from the central junction to the ends of the branches, this being in marked contrast to the flatness and levelness which was an essential of Swan's manifold. (See the illustration of this Dodge-Plymouth manifold at the bottom of the chart on the following page.)

Because of these important differences between respondent's manifolds and the Swan manifold, the patent claims defining the Swan manifold very naturally do not include respondent's manifolds. Respondent's manifolds were properly held by the Circuit Court of Appeals not to infringe because of their lack of such essential Swan features as the sharp corners at the inside of the turns, which had been present in the "first group" Nash manifolds and had accounted for the holding that those manifolds infringed in the earlier decision of the same Court in *Swan* v. *Reeke-Nash*. (See the illustration of the *Reeke-Nash* manifold just below the Swan manifold on the chart on the following page.)

The manifolds of respondent in this case could not have been held to be infringements, regardless of the language of the patent claims, because, with respect to every feature of construction, respondent's manifolds are a departure from the prior art *in the opposite direction* from the direction of Swan's departure from the prior art. Because of this fact, petitioner's patent claims could not possibly *exclude* the prior art, as they must in order to be valid, and at the same time *include* respondent's manifolds, which are more remote from Swan than is the prior art.

The impossibility of Swan's claims covering respondent's manifolds is graphically shown by the chart on the following page, on which the Swan manifold is shown at the top, the prior art Matheson and Fiat manifolds in the middle,

and respondent's Dodge-Plymouth manifold at the bottom. The line A-A on this chart, lying between Swan and the prior art, represents the extreme limit to which the field covered by Swan's claims can be extended without including the prior art and thereby making the claims invalid. Obviously, if this line were moved down on the chart far enough to include respondent's manifolds at the bottom of the chart within the field covered by Swan's claims, the claims would inevitably include the intervening prior art manifolds, and would therefore be invalid.

The Prior Litigation Involving the Swan Patents.

The litigation on the Swan patents is by no means as confused as the petition indicates. There is definitely no conflict between the decision sought to be reviewed and any decision on these patents in any other Circuit. In fact, petitioner has so handled the litigation that there could be no conflict. There has been only one other suit in which the validity of the patents has been in issue—and that suit was in the Sixth Circuit.

***Swan* v. *General Motors* (D. C. N. D. Ohio), 42 F. (2d) 452; affirmed (C. C. A. 6), 44 F. (2d) 24:**

The first suit in which either of the Swan patents was involved was not an infringement suit but was a suit against General Motors for royalties due, under its license agreement, on the round cross-section manifolds which it had substituted for the original square Swan manifolds. After discussing the unusual situation presented by this license agreement, the Court held that, under the agreement, royalties must be paid on these manifolds in spite of the differences between them and the Swan manifold. The key to the decision is the District Court's statement (p. 454) that

> "In view . . . of defendant's right to cancel [the license agreement], and its action in expressly refraining from so doing, it would seem that the

COMPARISON OF MANIFOLDS

SWAN

FIG. 8 OF ORIGINAL APPLICATION

Note the square cross-section and the sharp, square corners at the turns.

REEKE-NASH

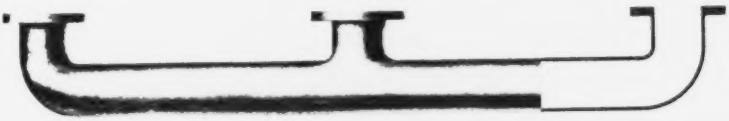
Held to infringe because of the sharp square corners at the inside of the turns.

This line A-A represents the maximum possible extent of the field of Swan's monopoly. If this field were extended any further toward respondent's manifolds at the bottom of the chart, Swan's field would include the intervening prior art manifolds, and the claims thereby invalidated.

A A A

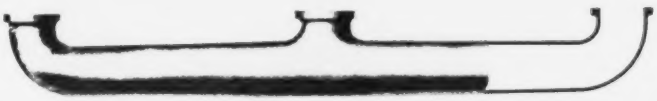
PRIOR ART

MATHESON



The sharpest of the three rounded bends illustrated on this chart.

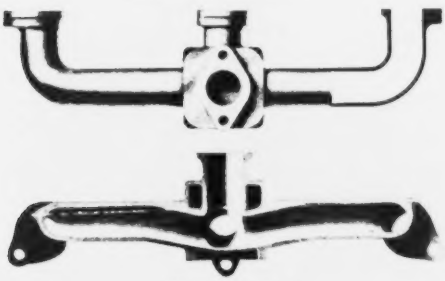
FIAT



More rounded than the bend above.

RESPONDENT'S

DODGE - PLYMOUTH



Still more rounded—i.e., further removed from Swan's square corners—than the prior art manifolds above.

(FRONT VIEW)

> patent claims ought not to be scrutinized with extreme care in order to find a way to save defendant from complying with its promise. . . ."

Also, these "first group" General Motors manifolds did have square corners on the inside of the turns within the manifold, and therefore resembled the Swan manifold rather than the prior art, with respect to this detail of construction. These first group General Motors manifolds were very similar to the Reeke-Nash manifolds shown on the chart on the preceding page.

Swan* v. *Reeke-Nash **(C. C. A. 6), 88 F. (2d) 876, 885:**

The second suit on these patents was an infringement suit against *Reeke-Nash,* the Cleveland dealer in Nash cars. Both patents were charged to be infringed by the "first group" Nash manifolds, manifolds of round cross-section which resembled closely the first group manifolds on which General Motors had been required to pay royalty. A special master and the District Court sustained all of the patent claims relied upon by plaintiff. The Circuit Court of Appeals refused to affirm the decision with respect to the "method" claims and some of the apparatus claims involved in the present suit, and ordered the complaint dismissed without prejudice so far as these claims were concerned. With respect to other claims the Circuit Court of Appeals sustained the decision below, finding that four of the claims in suit, two from each patent, were infringed by the Nash first group manifolds.

The key to this decision is the fact that the manifolds in issue had sharp, square corners at the inside of all turns within the manifold, like the first group General Motors manifolds on which the payment of royalties had already been required. Such a sharp corner is indicated by the red arrow in the illustration of the Reeke-Nash manifold on the chart on the preceding page.

***Swan* v. *General Motors* (second case) (C. C. A. 6), 88 F. (2d) 876:**

This was another suit for royalties due under the license agreement and involved some "second group" General Motors manifolds which differed only slightly from the adjudicated first group manifolds, and gave identical results. The case was tried before a jury, whose verdict was that royalties were due under the license agreement, as in the case of the first group manifolds.

On defendant's appeal, which was heard and decided by the Circuit Court of Appeals simultaneously with the *Reeke-Nash* case, *supra,* the issues were whether the license agreement might be reformed and whether the District Court's instructions to the jury had been correct. The holding was that the agreement would not be reformed and that the instructions to the jury had been proper.

All of the decisions referred to above were either rendered, or affirmed, by the same Circuit Court of Appeals which rendered the decision now sought to be reviewed. The joint opinion in the *Reeke-Nash* case and the second *General Motors* case was rendered by the same judges (Circuit Judges Hicks, Simons and Allen) as those who rendered the decision in the case at bar.

***Swan* v. *General Motors* (third case) (D. C. N. D. Ohio), 43 F. Supp. 499:**

This latest General Motors case, like its predecessors, was a suit at law for royalties under the same agreement as was involved in the earlier cases. The holding was that royalties were due, under the agreement, on various additional manifolds which had been adopted by General Motors. The decision, by a District Court of the same (Sixth) Circuit, was not appealed and General Motors has finally settled its differences with petitioner (Petition, p. 19).

We come now to the decision in the only suit on these patents that has been brought outside the Sixth Circuit, that of the Circuit Court of Appeals for the Fourth Circuit in the case of *Swan* v. *Nash*.

***Swan* v. *Nash* (C. C. A. 4), 105 F. (2d) 305:**

This suit was brought against the Nash Company itself for two separate but related purposes—first, to obtain an accounting of profits and damages on account of the first group manifolds, which had been held to infringe in plaintiff's earlier suit against the Nash dealer, *Reeke-Nash;* and second, to adjudicate new charges of infringement against some "second group" manifolds with which the Nash Company had replaced the infringing first group manifolds. Since the Nash Company had defended the *Reeke-Nash* case, it was admittedly bound by the result and no question was presented in the Fourth Circuit case as to validity or as to infringement by the first group manifolds. The sole issue presented was whether the new second group manifolds infringed the single claim that was charged to be infringed (claim 20 of the "divisional" patent, '044).

The charge of infringement against the second group Nash manifolds was based largely on the fact that they produced exactly the same results, in terms of engine performance, as the Swan manifold and the previously adjudicated first group manifold. The defense was that the second group manifolds could not infringe because they were in effect the prior art, being a reproduction of the prior art Matheson manifold in the smaller size required to fit the smaller engine used by Nash. The Circuit Court of Appeals sustained this defense and held that the second group Nash manifolds did not infringe the single claim in suit.

The Decision Sought to be Reviewed Is Not in Conflict with Any Decision on These Patents in Any Other Circuit.

As stated above, the only suit on these patents outside the Sixth Circuit is the suit of *Swan* v. *Nash*, in which it was held by the Circuit Court of Appeals of the Fourth Circuit that the second group (reduced Matheson) Nash manifolds did not infringe claim 20 of Swan patent '044.

The decision of the Circuit Court of Appeals for the Sixth Circuit in the present case is:

(1) That claims 5 and 7 of Swan patent '721 and claims 13 and 23 of Swan patent '044 are not infringed by the manifolds used on any of respondent's cars (Dodge, Plymouth, Chrysler and DeSoto), and

(2) That claims 4, 5, 8, 9, 10 and 22 of Swan patent '044 are invalid.

Thus the decision in the case at bar is not in conflict in any way with the decision of the Circuit Court of Appeals of the Fourth Circuit. On the contrary, it is entirely consistent. Both Courts held that the manifolds involved in their respective cases did not infringe the claim or claims that were charged to be infringed.

As a matter of fact, a conflict of decision between the case at bar and the Fourth Circuit case of *Swan* v. *Nash* was rendered impossible by petitioner's withdrawal from suit, at the opening of the trial of the case at bar, of claim 20 of patent '044, which was the only claim involved in the case of *Swan* v. *Nash*. This claim was originally charged to be infringed in the present case (I, 25). By the strategic withdrawal of claim 20 at the beginning of the trial of the case at bar (I, 140), petitioner was assured against a conflict of decision and consequent review by this Court, if it should succeed in obtaining a holding in the present case that respondent's manifolds were infringements of any of the claims remaining in suit.

The harmony between the decision in the case at bar and the Fourth Circuit decision extends to the question of validity, as well as the question of infringement. Though validity was not in issue in the Fourth Circuit case (because the Nash Company had defended the *Reeke-Nash* case and was bound by the result), and the Court therefore rendered no decision on validity, the Court did observe that doubt had been cast upon the validity of the patent by certain tests and testimony, there introduced for the first time, which showed that under the conditions of operation used in the Nash car (in which exhaust heat was used to vaporize a large part of the liquid fuel), a manifold of the prior art Matheson configuration produced almost identically the same results as a Swan manifold, both on the Nash and the original Matheson engines. 105 F. (2d) 305, 310. In the case at bar, which was decided after the decision in the Fourth Circuit case, and in which additional tests were presented showing that the results achieved by the prior art Matheson and Fiat manifolds were virtually identical with those achieved by the Swan manifold, both on the original Matheson and Fiat engines and on the Chrysler engine, the Circuit Court of Appeals of the Sixth Circuit proceeded to hold invalid several of the claims which it had not previously adjudicated, namely, the ambiguous "method" claims 4, 5, 8, 9 and 10 and the functional apparatus claim 22 of the "divisional" patent, '044.

Petitioner's Reasons for the Granting of a Writ of Certiorari Are Not Well Founded.

(1) *Alleged Conflict of Decision.* We have shown above that the decision in the case at bar is not in conflict with any decision on these patents in any other Circuit.

In its earlier suit against *Reeke-Nash,* petitioner succeeded in persuading the Circuit Court of Appeals for the Sixth Circuit that the prior art Matheson and Fiat manifolds were "prior efforts and failures". In the case at

bar the same Court was convinced by tests, not presented in the earlier case, that the prior art Matheson and Fiat manifolds were satisfactory manifolds, producing in fact results substantially identical with those produced by respondent's manifolds and by the Swan manifold, when operated with a corresponding degree of vaporization by heat.[1] This improved opinion of the prior art by the same Court, in the light of these further proofs, creates no conflict of decision entitling plaintiff to review by this Court.

Petitioner contends that the Court below erred "in permitting modifications of the prior art to qualify or limit petitioner's patent claims", citing alleged conflicting cases in the Second and Eighth Circuits. These cases are not in point for the prior art was not modified in the case at bar. As the Circuit Court of Appeals said in its opinion, respondent's manifolds were given road tests in comparison with manifolds constructed *"in exact conformity* with the prior art, namely, Matheson and Fiat, all equipped with exhaust heaters similar to those used in the accused devices". 130 F. (2d) 391, 392-393; V, 1853-1854. And further tests were made showing substantially the same results upon the original Matheson and Fiat engines, "using *the original manifolds* in comparison with manifolds of Swan's preferred form, appellee's [respondent's] heating means being applied in every case" (*id.*). The purpose of the heaters in these tests was the same as that of the heaters used on respondent's manifolds—to vaporize enough of the liquid portion of the fuel to obtain a relatively dry mixture, corresponding to the mixture distributed by these prior art manifolds when operating on the more volatile gasoline with which they were originally used (*supra,* p. 3). See also the District Court's Findings regarding these tests and the test manifolds (V, 1828-1831, paragraphs 15-19).

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[1] Vaporization by heat was no part of Swan's alleged invention; on the contrary, Swan warned against reliance on heat for vaporization as it reduces the volumetric efficiency or ultimate power produced ('721 patent, IV, 1222, lines 28-53; '044 patent, IV, 1208, lines 36-53).

Petitioner's complaint (Petition, p. 26) that the District Judge did not attend certain tests conducted by respondent is absurd. The tests were conducted *inter partes* and the numerical results are in the record. The reason why the District Judge was absent from the tests was that *petitioner* objected to his presence (II, 471-2).

(2) *Alleged Estoppel to Deny Validity.* Petitioner asserts that the Circuit Court of Appeals erred in not holding respondent estopped to deny the validity of the claims which it held invalid, by reason of what petitioner calls a "final decree against a privy of respondent", referring to the decree of the District Court in the *Reeke-Nash* case holding these claims valid. The shortest answer to this contention is that the decree referred to was a mere interlocutory decree, not a final decree on which alone an estoppel can be founded. In its decision in the case referred to (Reeke-Nash), on appeal from this allegedly "final" decree, the Circuit Court of Appeals (Sixth Circuit) expressly directed that the bill of complaint be dismissed without prejudice as to all of the claims now under discussion. 88 F. (2d) 888, last sentence. And a real final decree, dismissing the complaint without prejudice with respect to these claims, was then entered upon the mandate of the Circuit Court of Appeals, specifically superseding the interlocutory decree which petitioner mis-describes as "final" (I, 40, 42, paragraph 9).

Another answer to this contention is that respondent was not in privity with *Reeke-Nash,* as contended by petitioner. Petitioner's contention is based on the fact that respondent is a member of the Automobile Manufacturers Association, which participated in the defense of the *Reeke-Nash* case. Respondent contended in both Courts below that it was not in privity with *Reeke-Nash* and was not estopped to contest the validity of the claims held valid by the Circuit Court of Appeals in the *Reeke-Nash* case. The District Court sustained petitioner's contention on this issue and

the Circuit Court of Appeals did not discuss the matter, the issue being rendered moot by the Court's decision that the claims were not infringed.

If the petition for certiorari should be granted, respondent would ask this Court to reverse the decision on this point and to hold respondent free to show the invalidity of all of the claims in suit, as well as non-infringement.

(3) *The "Method" Claims.* We have already shown that the present decision that these claims are invalid is not in conflict with any decision on the patents in any other Circuit, and involves nothing more than the reversal by the Circuit Court of Appeals of the Sixth Circuit, on a more complete record, of an earlier decision by a District Court in its own Circuit.

Petitioner's statement that the form of the "method" claims was suggested by the Patent Office (Petition, p. 7) is not supported by petitioner's citation to the file wrapper. The file wrapper shows that the prosecution of the application resulting in the "divisional" patent '044, containing the method claims, was conducted in a most extraordinary manner. During the prosecution of the application, five separate amendments were filed, two of them substituting complete new sets of claims and one of them substituting a complete new specification, all without any official action on the case by the examiner. The claims as finally allowed were presented March 21, 1925, with the statement by the applicant that they were "in keeping with the understanding had with the Principal Examiner, on the occasion of recent conference". Notice of allowance by the examiner was filed April 2, 1925, and on the same day the final fee was paid by applicant, concluding the prosecution. The notice of allowance was the only action by the Patent Office during the entire prosecution (File Wrapper, *Reeke-Nash* record, Vol. IV, pp. 2020-2082).

The "method" claims are clearly invalid under the decisions of this Court, for indefiniteness and because they seek to monopolize all conceivable ways of accomplishing

the desired result, apart from the means for accomplishing that result which were proposed by the patentee. Such claims have always been forbidden by the patent law. *Mitchell* v. *Tilghman,* 86 U. S. 287, 391; *Fuller* v. *Yentzer,* 94 U. S. 288; *Holland Furniture Co.* v. *Perkins Glue Co.,* 277 U. S. 245, 257; *Knapp* v. *Morss,* 150 U. S. 221, 227-228; *Electric Signal Co.* v. *Hall Signal Co.,* 114 U. S. 87, 96; *Hubbell* v. *United States,* 179 U. S. 77, 86.

(4) *Claim 22.* The holding of the Circuit Court of Appeals that this claim was invalid because it defined in terms of function and result the allegedly new element to which it was directed is fully in accord with the decisions of this Court to which we have just referred.

(5) *Alleged Conflict as to Whether Swan Was a "Pioneer".* We have already seen that the only decisions as to the validity of the plaintiff's claims have been in the Sixth Circuit, and that the only decision on the issue of infringement outside the Sixth Circuit is the decision of noninfringement by the Circuit Court of Appeals of the Fourth Circuit in *Swan* v. *Nash,* which is in complete harmony with the decision in the case at bar (*supra,* pp. 12-13).

(6) *"Ignoring" the findings of the Special Master in the case of Swan* v. *Reeke-Nash, in holding claims 4, 5, 8, 9, 10 and 22 invalid.* In the earlier case of *Swan* v. *Reeke-Nash* the Circuit Court of Appeals had an opportunity to pass upon the validity of these claims, but found it unnecessary to do so because the full relief sought by the plaintiff was being awarded under other claims. In the present case, in which the other claims were found to be not infringed, the Circuit Court of Appeals was required to consider these claims and has held them to be invalid. What the Court could have done in the *Reeke-Nash* case, it can certainly do in this case in which the record is much less favorable to Swan.

Conclusion.

The petition shows no sound reason for the granting of a writ of certiorari to review the status of this expired patent. The well-considered decisions of the District Court and the Circuit Court of Appeals below, both reached the same result and rightly held petitioner's patents either invalid or not infringed. The decision of the Circuit Court of Appeals, adhered to after a petition for rehearing, is entitled to special weight because of the familiarity of that Court with the prior litigation on these patents.

The case presents no unsettled question of general or public importance and no question as to which there is a conflict of decision between the Circuits. The decision below is not in conflict with any decision of this Court and is manifestly right.

The petition should therefore be denied.

Respectfully submitted,

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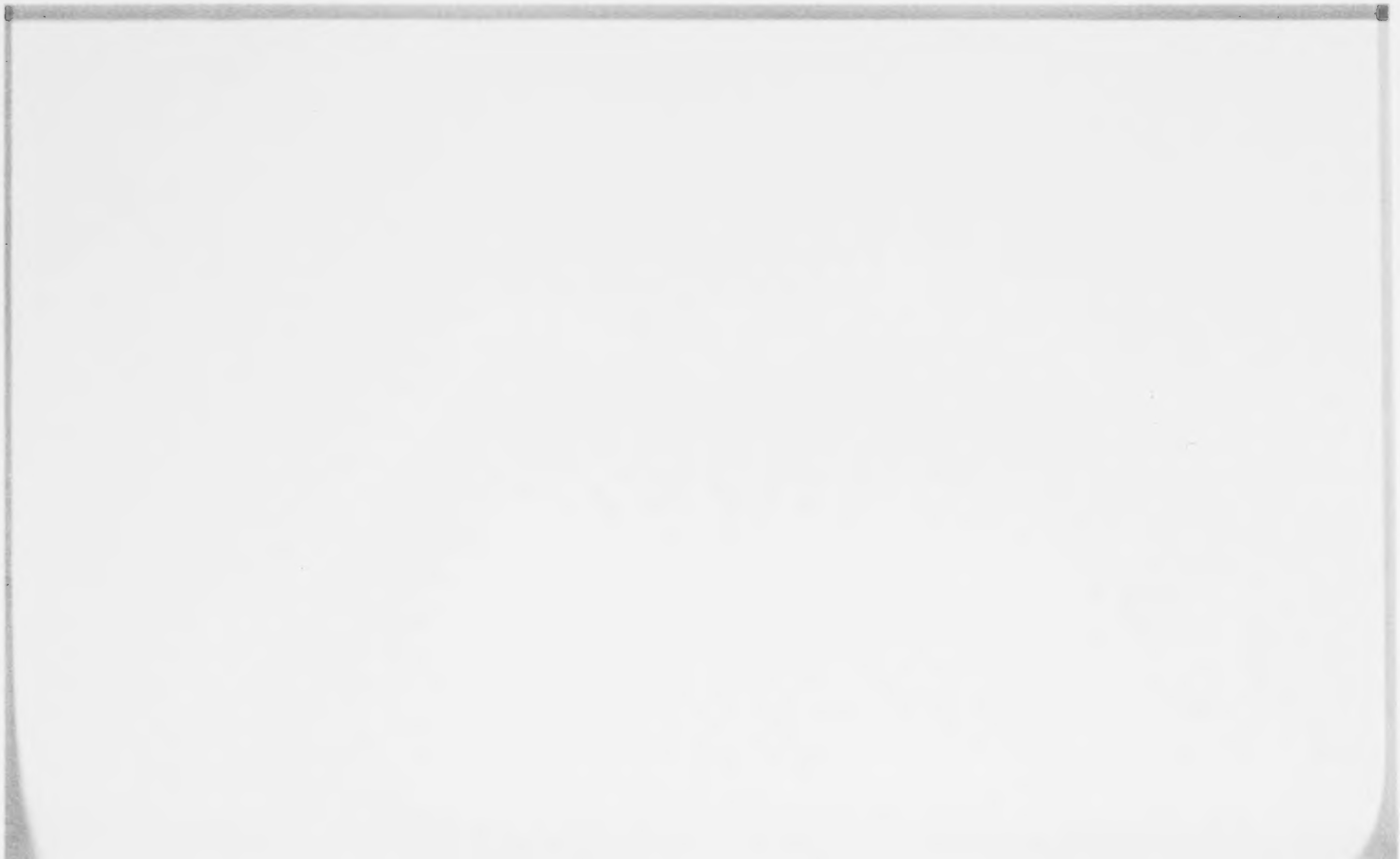
New York, New York.

December, 1942.



APPENDIX

APPENDIX

Swan's Statement Concerning His Invention

That the square cross-section passageways and sharp, square corners at the turns were in fact of the essence of the Swan invention is emphasized by the following statement made by Swan himself, in response to a specific question from the floor, during the discussion which followed the presentation of his paper to the Society of Automotive Engineers in 1923:

> "Mr. Taylor: How much advantage is derived from the squareness of the manifold and how much from the sharp corners and other characteristics of the Swan manifold?
>
> "J. W. Swan: * * * Now in a *round*[1] pipe *all*[1] the liquid deposited on the walls drains down the walls and naturally forms a stream-line in the bottom of this pipe, while in a square pipe the liquid deposited on the walls has a different action, as that which adheres to the top or ceiling either remains there to be carried forward with the next inrush of air, or if it drops off it falls to the flat level bottom. As the top and the bottom in the square section constitute one-half of the inside surface, it is readily seen that the liquid will not streamline but will spread out over the flat bottom that presents much greater surface for the liquid to come into contact with the air, thereby preventing stratification to a great extent. The sidewall drainage will also naturally spread out over the bottom. The virtue in the right-angle turns, and especially the turns from the vertical portion leading from the carbureter to the horizontal part, lies in the fact that the liquid particles in the mixture, due to their velocity and weight, cannot make a right-angle turn and are therefore carried up against the flat level ceiling from which they are swept into the branches, or failing to reach the ceiling are carried in the air stream somewhere between the right-angle turn and the ceiling and are not allowed

[1] Emphasis in original.

to flow around the inside of an elbow and stream, especially if the elbow is of circular cross-section.

"The right-angle turns at the ends of the horizontal branches are very similar in action to that at the center and prevent stratification and stream-lining, as in the case of the round-elbow type, thereby preventing flow to one cylinder in preference to the other at the entrance to the valve chamber" (V, 1678).